


TRANSMITTAL OF APPEAL BRIEF			Docket No. 345288017US
In re Application of: Naimark et al.			
Application No. 10/800,393-Conf. #7182	Filing Date March 12, 2004	Examiner N. Abel-Jalil	Group Art Unit 2165
Invention: ALERTING USERS TO ITEMS OF CURRENT INTEREST			
<p style="text-align: center;"><u>TO THE COMMISSIONER OF PATENTS:</u></p> <p>Transmitted herewith is the Appeal Brief in this application, with respect to the Notice of Appeal filed: <u>June 6, 2008</u> .</p> <p>The fee for filing this Appeal Brief is <u>\$ 510.00</u> .</p> <p><input checked="" type="checkbox"/> Large Entity <input type="checkbox"/> Small Entity</p> <p><input checked="" type="checkbox"/> A petition for extension of time is also enclosed.</p> <p>The fee for the extension of time is <u>\$120.00</u> .</p> <p><input type="checkbox"/> A check in the amount of _____ is enclosed.</p> <p><input checked="" type="checkbox"/> Charge the amount of the fee to EFT Account No. <u>SEA1PIRM</u> .</p> <p><input type="checkbox"/> Payment by credit card. Form PTO-2038 is attached.</p> <p><input checked="" type="checkbox"/> The Director is hereby authorized to charge any additional fees that may be required or credit any overpayment to Deposit Account No. <u>50-0665</u> .</p> <div style="display: flex; justify-content: space-between; align-items: flex-end; margin-top: 20px;"><div style="text-align: center;"> _____ Joseph F. Brennan Attorney Reg. No. : 62,403 PERKINS COIE LLP P.O. Box 1247 Seattle, Washington 98111-1247 (206) 359-8000</div><div style="text-align: right;">Dated: <u>September 8, 2008</u></div></div>			

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Naimark et al.

Application No.: 10/800,393

Confirmation No.: 7182

Filed: March 12, 2004

Art Unit: 2165

For: ALERTING USERS TO ITEMS OF
CURRENT INTEREST

Examiner: N. Abel-Jalil

APPELLANT'S BRIEF

MS Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This brief is in furtherance of the Notice of Appeal filed in this case on June 6, 2008.

The fees required under 37 C.F.R. § 41.20(b)(2) and any required petition for extension of time for filing this brief and fees therefore are dealt with in the accompanying TRANSMITTAL OF APPEAL BRIEF.

This brief contains items under the following headings as required by 37 C.F.R. § 41.37 and M.P.E.P. § 1205.2:

- I. Real Party in Interest
- II. Related Appeals and Interferences
- III. Status of Claims
- IV. Status of Amendments
- V. Summary of Claimed Subject Matter
- VI. Grounds of Rejection to be Reviewed on Appeal
- VII. Argument
- VIII. Claims Appendix
- IX. Evidence Appendix
- X. Related Proceedings Appendix

I. REAL PARTY IN INTEREST

The real party in interest for this appeal is Vulcan Patents LLC.

II. RELATED APPEALS AND INTERFERENCES

The appellant, the appellant's legal representative, and the real party in interest are unaware of any appeals, interferences, or judicial proceedings which may be related to, directly affect, or be directly affected by or have a bearing on the Board's decision in this appeal.

III. STATUS OF CLAIMS

A. Total Number of Claims in Application

There are 34 claims pending in the application.

B. Current Status of Claims

1. Claims canceled: 1-55
2. Claims withdrawn from consideration but not canceled: none
3. Claims pending: 56-89
4. Claims allowed: none
5. Claims rejected: 56-89

C. Claims on Appeal

The claims on appeal are claims 56-89.

IV. STATUS OF AMENDMENTS

The appellant has not filed any amendments after the last Office Action of February 6, 2008. The claims in Appendix A include the amendments filed by Applicant on January 3, 2008.

V. SUMMARY OF CLAIMED SUBJECT MATTER

A. Introduction

In the background section to the application, the applicants noted the explosive growth in the volume and diversity of content available on the Internet. (See "Background of the Invention" section of the specification.) The applicants further noted that much of the content is dynamic, and that at certain times such content may be of great interest, while at other times of little or no interest. (*Id.*) For example, a webcam pointed at a watering hole in Africa might provide frequently uninteresting video. (*Id.*) However, occasionally, such as when a rare animal appears at the watering hole, the webcam video may be of great interest. (*Id.*) A problem presented by such a situation is that users, unless they were watching the webcam video at the right moment, would have no way of knowing when such activity is occurring. (*Id.*)

Applicants' technology provides a solution to this particular problem and similar problems. Applicants' technology enables a participant, or first individual, to select categories in which they are interested in receiving alerts. An alerting user, or second individual who is not the participant, can provide a real time alert regarding a network accessible item based on a perceived change in its content. An interest category can be assigned to the real time alert. If the interest category corresponds to the category previously indicated by the participant, the participant can be notified in real time that the network accessible item is of interest to them. Using the above example, applicants' technology enables an alerting user, who is watching the webcam video and who sees a water buffalo appear at the watering hole, to submit an alert in real time. A participant, who is not the alerting user and who previously indicated an interest in seeing such displays, can be alerted in real time to the appearance of the water buffalo. The participant can thus access the webcam video to see the water buffalo. The participant thus need not constantly monitor the webcam video.

B. Independent Claim 56

Claim 56 is directed to a method of notifying a participant that a network accessible item is of current interest. The method includes, *inter alia*, providing an indication of interest in one or more interest categories. (See, e.g., specification at p. 24, line 21 to p. 25, line 2.) The method further includes receiving in real time at a first time via an alerting user an alert regarding the network accessible item. (See, e.g., specification at p. 13, lines 1-5; see also, e.g., Figure 3, element 302.) The alerting user and the participant are two different individuals. (See, e.g., specification at p. 4, lines 2-5; see also, e.g., Figure 1, elements 102 and 104.) The network accessible item is associated with content that changes over time, e.g., dynamic content. (See, e.g., specification at p. 9, lines 13-15.) The alert indicates that the content of the network accessible item at the current time is of interest. (See, e.g., specification at p. 9, lines 15-17.) The alert is based at least in part on a real time change, perceived by the alerting user, in the content of the network accessible item. (*Id.*) At least one interest

category is assigned to the network accessible item. (See, e.g., specification at p. 11, line 20 to p. 12, line 4.) The method further includes providing human-perceptible notification in real time at a second time to the participant that the network accessible item is of current interest. (See, e.g., specification at p. 24, lines 10-20; *see also*, e.g., Figure 11, elements 1102, 1104 and 1108.) The network accessible item is associated with at least one interest category in which the participant previously indicated interest. (See, e.g., specification at p. 24, line 21 to p. 25, line 2; *see also*, e.g., Figure 11, element 1106.) The second time is substantially the same as the first time. (See, e.g., specification at p. 9, lines 13-15.)

C. Independent Claim 71

Claim 71 is directed to an apparatus for notifying a participant that a network accessible item is of current interest. The apparatus includes, *inter alia*, a first interface component configured to receive from the participant an indication of interest in one or more interest categories. (See, e.g., specification at p. 10, lines 1-10, p. 24, line 21 to p. 25, line 2; *see also*, e.g., Figure 1, elements 105 and 106.) The apparatus further includes a communication component configured to receive in real time from an alerting user an alert regarding the network accessible item. (See, e.g., specification at p. 10, lines 1-10, p. 13, lines 1-5; *see also*, e.g., Figure 1, elements 105 and 106.) The network accessible item is associated with content that changes over time, e.g., dynamic content. (See, e.g., specification at p. 9, lines 13-15.) The alert indicates that the content of the network accessible item at the current time is of interest. (See, e.g., specification at p. 9, lines 15-17.) The alert is based at least in part on a real time change, perceived by the alerting user, in the content of the network accessible item. (*Id.*) The apparatus further includes a processor configured to process the alert. (See, e.g., specification at p. 10, lines 1-10; *see also*, e.g., Figure 1, elements 105 and 106.) The apparatus further includes a second interface component configured to provide notification in real time to the participant that the network accessible item is of current interest. (See, e.g., specification at p. 10, lines 1-10, p. 24, lines 10-20; *see also*, e.g.,

Figure 1, elements 105 and 106, Figure 11, elements 1102, 1104 and 1108.) The network accessible item is associated with at least one interest category in which the participant previously indicated interest. (See, e.g., specification at p. 24, line 21 to p. 25, line 2; see also, e.g., Figure 11, element 1106.)

D. Independent Claim 81

Claim 81 is directed to a method of notifying a participant that a network accessible item is of current interest. The method includes, *inter alia*, receiving from an alerting user an alert regarding the network accessible item in real time at a first time. (See, e.g., specification at p. 13, lines 1-5; see also, e.g., Figure 3, element 302.) The alerting user is a second individual who is not the participant. (See, e.g., specification at p. 4, lines 2-5; see also, e.g., Figure 1, elements 102 and 104.) The network accessible item is associated with content that changes over time, e.g., dynamic content. (See, e.g., specification at p. 9, lines 13-15.) The alert is based at least in part on a change, perceived by the alerting user, in the content of the network accessible item. (See, e.g., specification at p. 9, lines 15-17.) The method further includes assigning at least one category to the network accessible item. (See, e.g., specification at p. 11, line 20 to p. 12, line 4) The method further includes determining if the participant previously indicated an interest in the assigned at least one category. (See, e.g., specification at p. 26, lines 9-12; see also, e.g., Figure 12, element 1202.) The method further includes automatically notifying the participant in a human-perceptible manner that the network accessible item is of current interest at a second time that is substantially the same as the first time if the participant previously indicated an interest in the assigned at least one category. (See, e.g., specification at p. 9, lines 13-15, p. 24, line 10 to p. 25, line 2; see also, e.g., Figure 11, elements 1102, 1104, 1106 and 1108.)

E. Independent Claim 85

Claim 85 is directed to a computer system, comprising at least a memory and a processor, for notifying a participant that a network accessible item is of current interest.

The computer system includes, *inter alia*, means for receiving from the participant an indication of interest in one or more interest categories. (Means for performing a specified function under 35 U.S.C. § 112, sixth paragraph; structure, material, or acts corresponding to the specified function are described at, *see, e.g.*, specification at p. 24, line 21 to p. 25, line 2.) The computer system further includes means for receiving in real time at a first time via an alerting user an alert regarding the network accessible item. (Means for performing a specified function under 35 U.S.C. § 112, sixth paragraph; structure, material, or acts corresponding to the specified function are described at, *see, e.g.*, specification at p. 13, lines 1-5; *see also, e.g.*, Figure 3, element 302.) The alerting user is not the participant and both the alerting user and the participant are individuals. (*See, e.g.*, specification at p. 4, lines 2-5; *see also, e.g.*, Figure 1, elements 102 and 104.) The network accessible item is associated with content that changes over time, *e.g.*, dynamic content. (*See, e.g.*, specification at p. 9, lines 13-15.) The alert indicates that the content of the network accessible item at the current time is of interest. (*See, e.g.*, specification at p. 9, lines 15-17.) The alert is based at least in part on a real time change, perceived by the alerting user, in the content of the network accessible item. (*Id.*) The computer system further includes means for processing the alert. (Means for performing a specified function under 35 U.S.C. § 112, sixth paragraph; structure, material, or acts corresponding to the specified function are described at, *see, e.g.*, specification at p. 10, lines 1-10, p. 24, line 21 to p. 25, line 2; *see also, e.g.*, Figure 3, element 304.) The computer system further includes means for notifying in real time at a second time to the participant that the network accessible item is of current interest. (Means for performing a specified function under 35 U.S.C. § 112, sixth paragraph; structure, material, or acts corresponding to the specified function are described at, *see, e.g.*, specification at p. 24, lines 10-20; *see also, e.g.*, Figure 11, elements 1102, 1104 and 1108.) The network accessible item is associated with at least one interest category in which the participant previously indicated interest. (*See, e.g.*, specification at p. 24, line 21 to p. 25, line 2;

see also, e.g., Figure 11, element 1106.) The second time is substantially the same as the first time. (See, e.g., specification at p. 9, lines 13-15.)

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

A. The Examiner's Rejections

Claims 56-80 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of U.S. Patent No. 6,385,619 to Eichstaedt et al ("Eichstaedt"), U.S. Patent No. 5,893,091 to Hunt et al. ("Hunt") and U.S. Patent No. 6,803,945 to Needham et al. ("Needham").

B. The Issues on Appeal

Whether claims 56-89 are unpatentable under 35 U.S.C. § 103(a) over the combination of Eichstaedt, Hunt and Needham.¹

VII. ARGUMENT

A. Claims 56-89 Are Patentable Under 35 U.S.C. § 103(a) Over The Combination of Eichstaedt, Hunt and Needham

Claims 56-89 are patentable over the combination of Eichstaedt, Hunt and Needham under 35 U.S.C. § 103(a) for a number of reasons. One reason is that the applied references do not teach or suggest all of the features of each of claims 56-89. For example, each of the claims recites that an alert is based at least in part on a change, perceived by a human individual providing the alert, in content of an item accessible over a network (i.e., an item containing dynamic content.) None of the applied references teach or suggest this feature. A second reason is that there is no teaching, suggestion or motivation to modify Eichstaedt in the manner proposed by the Examiner. For example, the modification to Eichstaedt proposed by the Examiner

¹ The appellants have grouped the claims to simplify issues on appeal. The appellants, however, do not admit that the claims in any group stand or fall together for purposes other than this appeal. In particular, the appellants reserve the right to argue the patentability of each claim separately in a subsequent action, such as reopened prosecution or litigation.

would render Eichstaedt unsatisfactory for its intended purpose. Another reason is that the Examiner has not clearly articulated why claims 56-89 would have been obvious. For at least these reasons claims 56-89 are patentable over the combination of Eichstaedt, Hunt and Needham under 35 U.S.C. § 103(a). Accordingly, the Board should reverse the Examiner's rejections of claims 56-89.

1. Legal Requirements for Obviousness

35 U.S.C. § 103(a) provides:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

In the case of *KSR Int'l Co. v. Teleflex Inc.*, 82 U.S.P.Q.2d 1385, (U.S. 2007), the Supreme Court reaffirmed the framework set forth in *Graham v. John Deere Co. of Kansas City*, 148 U.S.P.Q. 459 (U.S. 1966), for applying the statutory language of § 103(a). The *Graham* framework requires that the Examiner perform the following analysis:

Under §103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background the obviousness or nonobviousness of the subject matter is determined. Such secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented.

(*KSR*, 82 U.S.P.Q.2d at 1391 (quoting *Graham*, 148 U.S.P.Q. at 467).)

As a preliminary matter, the Examiner has not analyzed any of claims 56-89 in accordance with the *Graham* framework, for at least the reason that the Examiner has not resolved the level of ordinary skill in the pertinent art, as required by *Graham* and *KSR*.

The M.P.E.P. provides exemplary rationales that can support a conclusion of obviousness, including: 1) "combining prior art elements according to known methods to yield predictable results;" and 2) "some teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or to combine prior art reference teachings to arrive at the claimed invention." (M.P.E.P. § 2143.) It appears that the Examiner used either or both of these rationales to support the rejections of the claims under 35 U.S.C. § 103(a) in the Office Action mailed February 6, 2008 ("Office Action.")

To reject a claim based on the first rationale, after resolving the *Graham* factual inquiries, the Examiner must articulate the following:

1) a finding that the prior art included each element claimed, although not necessarily in a single prior art reference, with the only difference between the claimed invention and the prior art being the lack of actual combination of the elements in a single prior art reference;

2) a finding that one of ordinary skill in the art could have combined the elements as claimed by known methods, and that in combination, each element merely performs the same function as it does separately;

3) a finding that one of ordinary skill in the art would have recognized that the results of the combination were predictable; and

4) whatever additional findings based on the Graham factual inquiries may be necessary, in view of the facts of the case under consideration, to explain a conclusion of obviousness.

(M.P.E.P. § 2143.) "If any of these findings cannot be made, then this rationale cannot be used to support a conclusion that the claim would have been obvious to one of ordinary skill in the art." (*Id.*) As the following will make clear, all of these findings cannot be made because all the claimed features were not described in the applied references. Therefore, claims 56-89 cannot be rejected under 35 U.S.C. § 103(a) using this rationale.

To reject a claim based on the second rationale, after resolving the *Graham* factual inquiries, the Examiner must articulate the following:

1) a finding that there was some teaching, suggestion, or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings;

2) a finding that there was reasonable expectation of success; and

3) whatever additional findings based on the Graham factual inquiries may be necessary, in view of the facts of the case under consideration, to explain a conclusion of obviousness.

(M.P.E.P. § 2143.) "If any of these findings cannot be made, then this rationale cannot be used to support a conclusion that the claim would have been obvious to one of ordinary skill in the art." (*Id.*) As the following will make clear, all of these findings cannot be made because there is no teaching, suggestion or motivation to modify the applied references in the manner proposed by the Examiner. Therefore, claims 56-89 cannot be rejected under 35 U.S.C. § 103(a) using this rationale.

2. The Applied References

a. Eichstaedt

Eichstaedt describes a system in which a user's access to a set of structured documents is analyzed for the purposes of pushing customized information back to that same user. (See Eichstaedt at 3:14-19; see also Figure 2.) For example, Eichstaedt's system analyzes the user's access to categorized documents at a web site. (Eichstaedt at 1:35-38.) Eichstaedt describes automatically generating a user interest profile based on the type of content viewed by the user. (Eichstaedt at 1:42-44.) Eichstaedt describes that the user interest profiles change constantly to "more accurately reflect the current interests of an individual." (Eichstaedt at 1:53-55.) In sum, Eichstaedt describes a personalization or customization system for tailoring content to a user.

b. Hunt

Hunt describes a system in which servers, called "Timely Information Providers" provide content to another server, called a "Timely Information Server," which then provides the content to users. (See Hunt at 4:38-55; see also Figure 2.) Hunt describes three types of Timely Information Providers: active providers, independent providers, and passive providers. (Hunt at 11:59-62.) Active providers submit pre-formatted, pre-tagged and pre-indexed alerts. (Hunt at 11:62-64.) Independent providers perform these functions and also stream a private channel. (Hunt at 11:64-12:3.) Passive providers do not tag or index alerts, and thus the Timely Information Server monitors the passive provider's website. (Hunt at 12:3-9.) It is clear from the described functions that all three types of Timely Information Providers are computers. Indeed, Hunt's Figure 9 shows these as computers. (Hunt, Figure 9, element 64 "Timely Information Provider Computer.") In sum, Hunt relies on servers, not individuals, to provide content to users.

c. Needham

Needham describes a camera system that periodically uploads images captured by a video camera. (Needham at 2:20-25.) The camera system uses one of several motion detection algorithms to detect motion in images captured by the video camera and for determining which images to upload to the web server. (*Id.*) Needham describes three types of algorithms for detecting motion: 1) a basic mode that compares pixels of a current image frame with pixels of a previously captured image frame, (Needham at 4:3-10); 2) a stable-change mode that compares a current frame against a last stable frame and selects as a candidate picture the last stable frame when no motion has been detected for a certain duration, (Needham at 4:36-41); and 3) a novel mode that compares an image that contains motion against the most recent stable image. (Needham at 4:55-60.) Needham describes that these algorithms are implemented in a software program running on a processor. (Needham at 3:60-65 and 4:23-35.) In sum, Needham relies on a computer to detect motion in the field of view of a video camera.

3. Claims 56-89: The Combination of Eichstaedt, Hunt and Needham Does Not Support a Finding That the Prior Art Included Each Element Claimed

As noted above, to reject claims 56-89 based on the rationale that the features of these claims are described in the applied references and can simply be combined according to known methods to yield predictable results, the Examiner must make a finding that the applied references included each feature in the claims. However, the Examiner cannot make this finding because the applied references do not teach all the features of these claims.

Claim 56 is directed to a method of notifying a participant that a network accessible item is of current interest. The method includes, *inter alia*, receiving in real time at a first time via an alerting user an alert regarding the network accessible item. The alerting user is an individual, i.e., a human individual. The alert is based at least in

part on a real time change, perceived by the alerting user, in the content of the network accessible item. Independent claims 71, 81 and 85 recite similar elements.

Eichstaedt does not disclose these features. Rather, Eichstaedt describes a webcasting system that pushes customized content to a single user. (Eichstaedt at 3:14-20; see also Figure 2, element 64 "webcasting system.") A webcasting system is a computer-based system. A computer-based system that pushes content is not the same as an alerting user providing an alert based on a change perceived by the alerting user. Hunt also does not disclose these features. Rather, Hunt describes servers providing content to other servers, which then provide the content to users.

In the Office Action, the Examiner recognized that the combination of Eichstaedt and Hunt does not disclose these features. (Office Action at p. 4: "The combination of Eichstaedt et al. with the teaching of Hunt et al. ... does not teach the alerting user is not the participant and both the alerting user and the participants are individuals; real time change perceived by the alerting user.")

To cure these deficiencies, the Examiner relies on Needham. (Office Action at p. 5.) However, Needham also does not teach or suggest these features. Rather, Needham describes motion detection that is performed by a computer, i.e., a non-human actor. In contrast, claim 56 recites that the alert is based at least in part on a real time change, perceived by the alerting user, in the content of the network accessible item, and that the alerting user is an individual, i.e., a human actor. Motion detection by a computer (what Needham describes) is not the same as a human perceiving a change in the content of a network accessible item (what is recited in claim 56). Therefore, Needham does not teach or suggest that the alert is based on a real time change perceived by the alerting user.

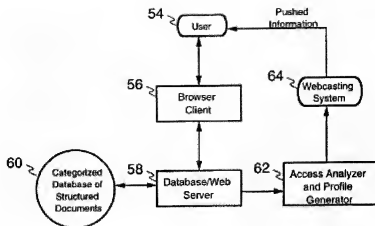
Based on the foregoing, it is clear that Eichstaedt, Hunt and Needham, either individually or collectively, do not teach or suggest that the alert is based on a real time

change perceived by the alerting user. Therefore, the Examiner cannot make a finding that the prior art includes each element claimed. Accordingly, the Examiner cannot reject claims 56-89 based on the rationale that the features of these claims are described in the applied references and can simply be combined according to known methods to yield predictable results.

4. There is no Teaching, Suggestion or Motivation to Modify Eichstaedt in the Manner Proposed by the Examiner

As noted above, to reject claims 56-89 based on the rationale that there is some teaching, suggestion, or motivation in the applied references to modify or combine them to arrive at claims 56-89, the Examiner must make a finding that there was some teaching, suggestion, or motivation, either in the applied references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the applied references or to combine their teachings. However, there is no teaching, suggestion or motivation in the applied references to modify or combine them in the manner proposed by the Examiner, for at least the reason that the modification to Eichstaedt proposed by the Examiner would render it unsatisfactory for its intended purpose.

Eichstaedt describes a personalization or customization system for tailoring content to a user's interests. A user accesses categorized documents at a web site. The user's access is analyzed for purposes of tailoring personalized content to the user. This personalized content is then pushed back to the user. In other words, Eichstaedt describes a single-user system. This is clearly shown in Eichstaedt's Figure 2, which shows only one user 54. This figure is reproduced below:

**FIG. 2**

In contrast, applicant's technology is directed to a multi-user system, in which there are at least two users, both of which are human individuals. An alerting user can provide a real time alert regarding a network accessible item to a system, which then provides the alert in real time to a participant. That applicant's technology is multi-user is clearly shown in applicant's Figure 1, which includes an alerting user 102 and a participant 104. This figure is reproduced below:

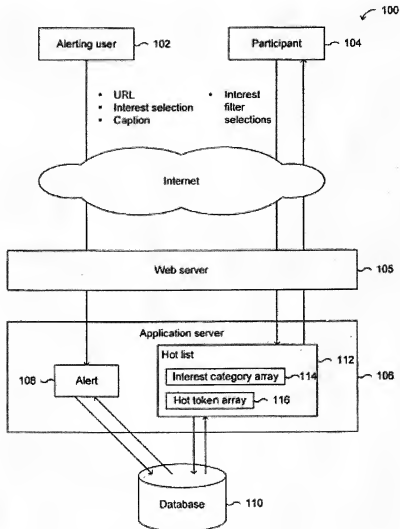


Figure 1

The Examiner proposes to modify Eichstaedt to introduce a second user into Eichstaedt's single-user system using the teachings of Hunt and/or Needham. The modification proposed by the Examiner would result in the second user accessing the categorized documents at the web site. The second user's access would be analyzed, and a user interest profile would be automatically generated based on the type of content viewed by the second user. Under the modification proposed by the Examiner,

Eichstaedt would utilize the second user's user interest profile to provide content to the first user.

However, this modification would result in providing content to the first user that is no longer customized for the first user. Rather, it would be customized for the second user. Such a modification would not allow Eichstaedt's system to provide personalized content to a user based on the user's preferences. According to the M.P.E.P., if the "proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification." (M.P.E.P. § 2143.01, quoting *In re Gordon*, 221 USPQ 1125 (Fed. Cir. 1984).) Because the modification proposed by the Examiner would render Eichstaedt's system unsatisfactory for its intended purpose of providing personalized content to a user based on the user's browsing activity, there is no teaching, suggestion or motivation to make the proposed modification.

Therefore, the Examiner cannot make a finding that there is some teaching, suggestion, or motivation, either in the applied references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the applied references or to combine their teachings. Accordingly, the Examiner cannot reject claims 56-89 based on the rationale that there is some teaching, suggestion, or motivation in the applied references that would have led one of ordinary skill to modify the applied references or to combine their teachings to arrive at claims 56-89.

5. The Examiner Has Not Clearly Articulated Reasons Why Claims 56-89 Would Have Been Obvious

According to the M.P.E.P., "[t]he key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious." (M.P.E.P. § 2143.) The Examiner has not clearly articulated why claims 56-89 would have been obvious. Rather, the Examiner has made the following statement:

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Eichstaedt et al. by the teaching of Hunt et al. to include real-time alerts between participant at first location, alerting user at second location, and processing the alert at a third location different from the first and second locations; and the network accessible item is associated with content that changes over time because it provides for efficient accessibility and accurate up-to-date information.

(Office Action, p. 4, citation omitted, emphasis in original.) Applicant notes that certain features referred to by the Examiner (e.g., first location, second location, third location) are not recited in any of claims 56-89.² A statement that refers to features that are not in any of the claims at issue cannot be considered a clear articulation of the reasons why claims 56-89 would have been obvious.

The Examiner has also made the following statement:

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have further modified Eichstaedt et al. as modified by the teaching of Needham to the alerting user is not the participant and both the alerting user and the participant are individuals; real time change perceived by the alerting user because it provides for efficient way to monitor real-life in-frequent events as they happen as to not miss updates that may occur less frequently as others.

(Office Action, p. 5, citation omitted, emphasis in original.) This statement is not a clear articulation of the reasons why claims 56-89 would have been obvious. At best, it is nothing more than the use of selected features of the pending claims to form a conclusion that is not supported by the applied references. At worst, this statement is the result of impermissible hindsight based upon applicant's disclosure, which is not permitted. "[I]mpermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art." (M.P.E.P. § 2142.) In either case, it is not a clear articulation of the reasons why claims 56-89 would have been obvious.

² Certain of these features were recited in now-canceled claims 21-55.

For at least these reasons, the Examiner has not clearly articulated why claims 56-89 would have been obvious. Accordingly, the Examiner has not made proper 35 U.S.C. § 103(a) rejections of claims 56-89.

B. Conclusion

For at least the reasons described above, each of pending claims 56-89 has been improperly rejected. There are no rationales that can be used to support a conclusion that the pending claims would have been obvious to one of ordinary skill in the art. Furthermore, the Examiner has not clearly articulated why the pending claims would have been obvious. Therefore, the pending claims cannot be rejected under 35 U.S.C. § 103(a). Accordingly, Board should reverse the Examiner's rejection of pending claims 56-89.

VIII. CLAIMS APPENDIX

A copy of the claims involved in the present appeal is attached hereto as Appendix A. As indicated above, the claims in Appendix A include the amendments filed by Applicant on January 3, 2008.

IX. EVIDENCE APPENDIX

The evidence appendix is attached hereto as Appendix B.

X. RELATED PROCEEDINGS APPENDIX

The related proceedings appendix is attached hereto as Appendix C.

Please charge any deficiency in fees or credit any overpayment to our Deposit Account No. 50-0665, under Order No. 345288017US from which the undersigned is authorized to draw.

Dated: September 8, 2008

Respectfully submitted,

By 

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APPENDIX A

Claims Involved in the Appeal of Application Serial No. 10/800,393

1-55. (Canceled)

56. A method of notifying a participant that a network accessible item is of current interest, the method comprising:

providing an indication of interest in one or more interest categories;

receiving in real time at a first time via an alerting user an alert regarding the network accessible item, wherein:

the alerting user is not the participant and both the alerting user and the participant are individuals;

the network accessible item is associated with content that changes over time;

the alert indicates that the content of the network accessible item at the current time is of interest;

the alert is based at least in part on a real time change, perceived by the alerting user, in the content of the network accessible item; and

at least one interest category is assigned to the network accessible item; and

providing human-perceptible notification in real time at a second time to the participant that the network accessible item is of current interest, wherein the network accessible item is associated with at least one interest category in which the participant previously indicated interest, and the second time is substantially the same as the first time.

57. The method of claim 56, wherein the network accessible item is identified by a Universal Resource Locator (URL).

58. The method of claim 56, wherein the alert includes an interest category specified by the alerting user.

59. The method of claim 56, wherein the processing further includes determining an alert intensity.

60. The method of claim 56, wherein the processing further includes determining an alert intensity based at least in part on the alerting user's identity.

61. The method of claim 56, further comprising storing data associated with the alert.

62. The method of claim 61, wherein the processing further includes using stored data associated with a previous alert.

63. The method of claim 61, wherein the processing further includes determining an intensity rank for the alert, and further comprising, if the intensity rank is below a threshold, deleting stored data associated with the alert.

64. The method of claim 56, wherein the processing further includes determining an intensity rank for the alert.

65. The method of claim 56, wherein the processing further includes determining an intensity rank for the alert that decays exponentially with time.

66. The method of claim 56, wherein the processing further includes determining an intensity rank for the alert, wherein the participant is notified about multiple network accessible items of current interest, and wherein the multiple network accessible items are selected based at least in part on intensity rank.

67. The method of claim 56, wherein the participant is notified about multiple network accessible items of current interest and the multiple network accessible items are ordered with respect to each other.

68. The method of claim 56, wherein the participant is notified about multiple network accessible items of current interest and the multiple network accessible items are selected based at least in part on a sensitivity level associated with the participant.

69. The method of claim 56, further comprising displaying to the participant content associated with the network accessible item of current interest.

70. The method of claim 56, wherein the alert includes a caption specified by the alerting user.

71. An apparatus for notifying a participant that a network accessible item is of current interest, the apparatus comprising:

- a first interface component configured to receive from the participant an indication of interest in one or more interest categories;
- a communication component configured to receive in real time from an alerting user an alert regarding the network accessible item, wherein:
 - the alerting user is not the participant and both the alerting user and the participant are individuals;
 - the network accessible item is associated with content that changes over time;

the alert indicates that the content of the network accessible item at the current time is of interest; and
the alert is based at least in part on a change, perceived by the alerting user, in the content of the network accessible item;
a processor configured to process the alert; and
a second interface component configured to provide notification in real time to the participant that the network accessible item is of current interest, wherein the network accessible item is associated with at least one interest category in which the participant previously indicated interest.

72. The apparatus of claim 71, wherein the network accessible item is identified by a Universal Resource Locator (URL).

73. The apparatus of claim 71, wherein the alert includes an interest category specified by the alerting user.

74. The apparatus of claim 71, wherein the processing includes assigning at least one interest category to the network accessible item.

75. The apparatus of claim 71, wherein the processing includes determining an alert intensity.

76. The apparatus of claim 71, further comprising a storage component configured to store data associated with the alert.

77. The apparatus of claim 76, wherein the processing includes using stored data associated with a previous alert.

78. The apparatus of claim 71, wherein the processing includes determining an intensity rank for the alert, wherein the participant is notified about multiple network accessible items of current interest and wherein the multiple network accessible items are selected based at least in part on intensity rank.

79. The apparatus of claim 71, further comprising a third interface component configured to display to the participant content associated with the network accessible item of current interest.

80. The apparatus of claim 71, wherein the alert includes a comment specified by the alerting user.

81. A method of notifying a participant that a network accessible item is of current interest, the method comprising:

- receiving from an alerting user an alert regarding the network accessible item in real time at a first time, wherein:

 - the alerting user is a second individual who is not the participant;

 - the network accessible item is associated with content that changes over time; and

 - the alert is based at least in part on a change, perceived by the alerting user, in the content of the network accessible item;

- assigning at least one category to the network accessible item; and

- if the participant previously indicated an interest in the assigned at least one category, automatically notifying the participant in a human-perceptible manner that the network accessible item is of current interest at a second time that is substantially the same as the first time.

82. The method of claim 81, wherein the network accessible item is identified by a Universal Resource Locator (URL).

83. The method of claim 81, wherein the alert includes a category specified by the alerting user.

84. The method of claim 81, wherein the alert includes a comment specified by the alerting user.

85. A computer system comprising at least a memory and a processor for notifying a participant that a network accessible item is of current interest, the computer system comprising:

- means for receiving from the participant an indication of interest in one or more interest categories;

- means for receiving in real time at a first time via an alerting user an alert regarding the network accessible item, wherein:

- the alerting user is not the participant and both the alerting user and the participant are individuals;

- the network accessible item is associated with content that changes over time;

- the alert indicates that the content of the network accessible item at the current time is of interest; and

- the alert is based at least in part on a real time change, perceived by the alerting user, in the content of the network accessible item;

- means for processing the alert; and

- means for notifying in real time at a second time to the participant that the network accessible item is of current interest, wherein the network accessible item is associated with at least one interest category in

which the participant previously indicated interest, and wherein the second time is substantially the same as the first time.

86. The system of claim 85, wherein the network accessible item is identified by a Universal Resource Locator (URL).

87. The system of claim 85, wherein the alert includes an interest category specified by the alerting user.

88. The system of claim 85, wherein the processing includes assigning at least one interest category to the network accessible item.

89. The system of claim 85, wherein the processing includes determining an alert intensity.

APPENDIX B

No evidence pursuant to 37 C.F.R. §§ 1.130, 1.131, or 1.132 or any other evidence entered by or relied upon by the Examiner is being submitted.

APPENDIX C

No related proceedings are referenced in Section II. above, hence copies of decisions in related proceedings are not provided.